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DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

CARTER, MONICA SMITH

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES D. REDMOND and DAWN E. DEPREY

Appeal 2008-0207
Application 09/090,067
Technology Center 3700

Decided: March 27, 2008

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and MICHAEL
W. O'NEILL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James D. Redmond and Dawn E. Deprey (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-6, 8-10, 13, 18, 19, 21, and 23-26, which are all of the pending claims in this application.¹ We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is to the use of micro-printing on identification cards to inhibit alteration or forgery of the cards (Spec. 1:4-6). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An identification document comprising:
first printed matter rendered at a first location on said document and at a first scale enabling said first printed matter to be resolved by a viewing person without magnification, said first printed matter conveying identifying information;
second printed matter comprising information that communicates the same identifying information as said first printed matter, the second printed matter rendered at a second microscale and at a second confidential location on

¹ Claims 11, 14-16, and 20 were also finally rejected, but the Appellants canceled these claims in an Amendment filed with Appellants' Appeal Brief. The Examiner entered this Amendment, as noted in an Advisory Action mailed July 26, 2004.

said document and in a second color, said second microscale being significantly smaller than said first scale, said second confidential location being spaced from said first location and being selected and arranged to be a location that is not generally known, and said second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background;

wherein the combination of said minimal contrast, said second confidential location, and said second microscale is constructed and arranged to substantially hide the existence and location of said second printed matter from the naked eye and prevent said second printed matter from being substantially detected or resolved unless a viewing party knows the second confidential location and views said second printed matter using a magnification lens.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Dow	US 1,428,278	Sep. 5, 1922
Richardson	US 4,239,261	Dec. 16, 1980
Trew	GB 2 159 461 A	Dec. 4, 1985

The Appellants seek our review of the Examiner's rejection of claims 1, 3-6, 8-10, 13, 18, 19, 21, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Trew, Dow, and Richardson.²

² The Examiner withdrew the final rejection of claims 1, 3-6, 8-11, 13-16,

ISSUE

The Appellants contend that the Examiner erred in rejecting claim 1 because neither Dow nor Robinson teaches printing an image in a color that, to the naked eye, has minimal contrast with its immediate background (App. Br. 21-22) and that any such modification to Trew would render Trew unsatisfactory for its intended purpose (App. Br. 23).

The Examiner found Dow's disclosure of using colors having different optical properties and colors printed in various hues satisfies the claim recitation of having printed matter in first and second colors where the colors have minimal contrast (Ans. 5). The Examiner concluded that it would have been obvious to modify the Trew document with the two different hues of color as taught in Dow to provide another means by which to protect the document from fraud/anti-counterfeiting attempts (*id.*).

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 3-6, 8-10, 13, 18, 19, 21, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Trew, Dow, and

and 18-20 under 35 U.S.C. § 112, second paragraph, in view of the claim amendments filed with Appellants' Appeal Brief (Ans. 4). The Appellants noted in their Appeal Brief that "[t]he rejection of claims 11, 13, 15, and 20 is not being appealed, and applicant reserves the right to pursue these claims in a related application" (App. Br. 7). This statement is moot as to canceled claims 11, 15, and 20. As to pending claim 13, we understood the Appellants to mean that they are not appealing the rejection under 35 U.S.C. § 112, second paragraph of claim 13, but that they are contesting the rejection of claim 13 under 35 U.S.C. § 103(a). This understanding is borne out by the Appellants' arguments presented in the briefs specifically contesting the rejection of claim 13 under 35 U.S.C. § 103(a).

Richardson. This issue turns on whether one having ordinary skill in the art would have been led to modify Trew to use a second color for printing second printed matter where the second color is selected to effect minimal contrast between the second printed matter and its immediate background, in view of the teachings of Dow.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Trew discloses a credit card or the like on which micro-print data may be printed to prevent fraudulent use or forgery of the card (Trew, p. 1, ll. 5-19 and 53-57).
2. Trew discloses that the card may include identification information of the authorized holder (Trew, p. 1, ll. 107-115).
3. Trew discloses that the micro print data is applied to either a transparent window area for passage of light there through, or to an area with a backing of white or other suitable light color so that the data can be effectively viewed by reflected light (Trew, p. 1, ll. 48-52 and 82-94).
4. Trew discloses that the micro print information is not visible to the naked eye even with the aid of a magnifying lens, and thus the

viewer must use a suitably adapted reader or projector or an epidiascope in order to read the micro print information (Trew, p. 1, l. 127 – p. 2, l. 8).

5. Trew does not disclose the micro print information is rendered in a second color where the second color is selected to effect minimal contrast between the micro print information and its immediate background.
6. Dow discloses a technique useful to render documents of value difficult to counterfeit (Dow, p. 1, ll. 12-19).
7. In particular, Dow discloses printing different portions of a figure or design with inks having the same color to the naked eye but possessing different optical properties so that when viewed through a spectroscope or equivalent optical instrument that is sensitive to color, the two portions of the figure or design will appear differently (Dow, p. 1, ll. 41-62).
8. As such, Dow discloses rendering printed matter in a second color that presents no contrast between the printed matter and its immediate background when viewed by the naked eye or with the aid of a microscope.
9. Richardson discloses micro-sized marking labels, each having optically-coded identification indicia and being sufficiently small in size so as to be substantially invisible to the casual observer

when mounted on the article to be identified (Richardson, col. 4, ll. 22-29 and col. 5, ll. 25-27).

10. Richardson does not disclose the marker is rendered in a second color where the second color is selected to effect minimal contrast between the marker and its immediate background.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

The Court in *KSR* explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design

community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.”

Id. at 1740-41. “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *Id.* at 1743.

ANALYSIS

Independent claims 1 and 21 recite an identification document and method, respectively, having second printed matter or information rendered in a second color, where the second color is selected to effect minimal contrast between the second printed matter and its immediate background.

All three references relied on by the Examiner are concerned with adding printed matter to a surface in a manner so that it is not readily visible to the naked eye. Each reference, however, discloses markedly different techniques to achieve this result, and none of the references disclose using a second color to effect minimal contrast between second printed matter and its immediate background (Facts 5, 8, 10).

Trew discloses a credit card or the like on which micro-print identification data may be printed to prevent fraudulent use or forgery of the card (Facts 1 & 2). The micro print data is applied to a window area that is made of exposed transparent material for passage of light there through, or is

applied to an area that is provided with a backing or white or other suitable light color so that the data can be effectively viewed by reflected light (Fact 3). The micro print information is not visible to the naked eye even with the aid of a magnifying lens, and thus the viewer must use a suitably adapted reader or projector or an epidiascope in order to read the micro print information (Fact 4). Trew does not disclose the micro print information is rendered in a second color where the second color is selected to effect minimal contrast between the micro print information and its immediate background (Fact 5).

Richardson discloses micro-sized marking labels that are not easily visible to the naked eye (Fact 9). Richardson likewise does not disclose the marker is rendered in a second color where the second color is selected to effect minimal contrast between the marker and its immediate background (Fact 10).

Dow discloses a technique useful to render documents of value difficult to counterfeit. Dow's technique prints different portions of a figure or design with inks having the same color to the naked eye but possessing different optical properties so that when viewed through a spectroscope or equivalent optical instrument that is sensitive to color, the two portions of the figure or design will appear differently (Facts 6 & 7). As such, Dow discloses rendering printed matter in a second color that has no contrast between the printed matter and its immediate background when viewed by the naked eye or with the aid of a microscope (Fact 8). The use of the word

“minimal” in claims 1 and 21 implies that there must be some contrast between the color of the second printed matter and the color of its immediate background. At least to the naked eye, the colors used Dow have no contrast.

Further, even if the claims were construed broadly enough so that the “minimal contrast” limitation were met by Dow’s technique, because Trew’s printed matter is already unascertainable by the naked eye or with the aid of a magnification lens such that it remains confidential, we see no reason why one having ordinary skill in the art would have had a reason to modify Trew using Dow’s technique absent hindsight. As such, we do not sustain the Examiner’s rejection of independent claims 1 and 21, or their dependent claims 3-6, 8-10, 13, 18, 19, and 23-26, under 35 U.S.C. § 103(a) as unpatentable over Trew, Dow, and Richardson.

CONCLUSIONS OF LAW

We conclude the Appellants have shown that the Examiner erred in rejecting claims 1, 3-6, 8-10, 13, 18, 19, 21, and 23-26 under 35 U.S.C. § 103(a) as unpatentable over Trew, Dow, and Richardson.

DECISION

The decision of the Examiner to reject claims 1, 3-6, 8-10, 13, 18, 19, 21, and 23-26 is reversed.

Appeal 2008-0207
Application 09/090,067

REVERSED

JRG

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